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REMARKS

The Examiner has rejected Claim 7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claim 7, the Examiner takes issue with the claimed "previous [pre-paid] debit account" since it is allegedly unclear. Further, the Examiner states that the claim will be interpreted as "[t]ransferring the payment from a first existing customer bank debit account before enabling the pre-paid second phone debit account in response to the request." In addition, the Examiner argues that "[i]f the applicant is trying to explain that many users will have a first already existing debit account with a bank that they will use to establish the "mobile phone usage or second account" then this should be explained in more detail."

Applicant respectfully disagrees with the foregoing rejection, and asserts that it is clear, from the claim language itself, that the "previous pre-paid debit account," as disclosed and claimed by applicant, should be interpreted as a pre-paid debit account that was previously established. See, for example, Page 10, lines 14-21 of the specification which clearly states that "the user may transfer payment from another pre-paid debit account such as one previously established."

In addition, the Examiner has rejected Claims 1-11, and 18-28 under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent No. 6,868,391), in view of Official Notice. Applicant respectfully disagrees with such rejection.

With respect to the independent claims, the Examiner has relied on item 300 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of applicant's claimed "prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment

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therefor" (see this or similar, but not necessarily identical language in the independent claims).



(Hultgren, Figure 3A, item 300)

"At telepay TSN 30, upon initially handling the call customer communications, module 202 obtains a customer identifier (e.g., customer directory number) from the call signaling which sets up the call (see step 300 in FIG. 3A)." (Hultgren, Col. 6, lines 22-26, not specifically cited - emphasis added).

Applicant respectfully asserts that item 300 in Figure 3A from Hultgren simply teaches that "module 202 obtains a customer identifier (e.g., customer directory number) from the call signaling which sets up the call (see step 300 in FIG. 3A)" (emphasis added). However, simply disclosing that a customer identifier is obtained, in no way suggests "prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment therefor" (emphasis added), as claimed by applicant.

In the Office Action mailed 08/24/2006, the Examiner has argued that "it is inherent that would you obtain a customer identification for those that request the payment transfer service or debit account." In addition, the Examiner has argued that "'receiving a request for a debit account" would be included in practically all prior art that includes a debit account, you would not establish an account unless the customer request[ed] it.'

Again, applicant respectfully disagrees, and emphasizes that simply disclosing that a customer identifier is obtained, in no way suggests "prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment therefor" (emphasis added), as claimed by applicant. Further, the Examiner's purported knowledge that "you would not establish an account unless the customer request it" (emphasis added) is not inherent in the method

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and apparatus of Hultgren, which simply discloses “a service node (TSN) which facilitates payment/transfer from a customer account of a customer financial institution to a merchant account of a merchant financial institution” (Col. 1, lines 55-58 – emphasis added). Clearly, facilitating payment between a customer account and a merchant account, as in Hultgren, fails to inherently suggest a situation where “prior to allowing wireless network voice communication and IP usage over a wireless network,...a request for a pre-paid debit account including payment therefore [is received]” (emphasis added), in the manner as claimed by applicant.

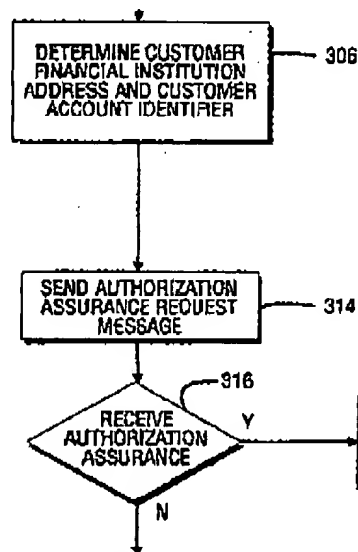
It appears that the Examiner has relied on an inherency/Official Notice argument regarding the above emphasized claim limitations. Regarding the inherency argument, applicant respectfully asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). In view of the arguments made hereinabove, any inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

Further, regarding the Examiner’s general reliance on Official Notice, applicant formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

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Furthermore, with respect to the independent claims, the Examiner has relied on items 306, 314, and 316 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of applicant's claimed "prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request" (see this or similar, but not necessarily identical language in the independent claims).



(Hultgren, Figure 3A, items 306, 314, and 316)

"At step 306, telepay TSN 30 determines the customer financial institution address and the customer account identifier at the customer financial institution. In particular, at step 306 the transfer coordination module 206 sends to the financial institution communication module 208 a signal which includes the current transaction code, the current customer identifier, and (optionally) the transaction amount." (Col. 6, line 66 to Col. 7, line 5, not specifically cited - emphasis added)

"The authorization assurance request message is routed by customer financial institution interface 208-1 over data network N to the customer financial institution address obtained at step 314. The authorization assurance request message, indicated as event E5 in FIG. 1, includes the transaction code, the customer account identifier, the transaction amount, and a message type code." (Col. 7, lines 24-30, not specifically cited - emphasis added)

"As indicated by step 316 of FIG. 3A, if the authorization assurance message is negative (indicating that authorization is

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not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318). Otherwise, as shown by step 320, the customer financial institution address and customer account identifier obtained from step 306, along with an indication of receipt of a positive authorization assurance message, are stored in the record for the current transaction in transaction database 220." (Col. 7, lines 39-47, not specifically cited - emphasis added)

Applicant respectfully asserts that items 306, 314 and 316 in Figure 3A from Hultgren relied upon by the Examiner merely disclose "determin[ing] the customer financial institution address and the customer account identifier at the customer financial institution" (emphasis added). Hultgren also discloses that "[t]he authorization assurance request message is routed ... to the customer financial institution address obtained at step 314" (emphasis added). In addition, Hultgren discloses receiving "the authorization assurance message" in step 316.

However, determining the customer financial institution address and the customer account identifier in order to route the authorization assurance request message simply fails to disclose any sort of enabling, let alone "enabling the pre-paid debit account in response to the request" (emphasis added), as claimed by applicant. Moreover, determining the customer financial institution address and the customer account identifier in order to route the authorization assurance request message in no way suggests "prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request" (emphasis added), as claimed by applicant.

In the Office Action mailed 08/24/2006, the Examiner has argued that "items 306, 314 & 316...outline enabling the process" and that the Examiner "is interpreting the broadest reasonable interpretation and these step[s] certainly would include enabling the process."

First, applicant respectfully disagrees and asserts that applicant claims "enabling the pre-paid debit account," and not simply "enabling a process" where such process simply "assure[s] that the customer account has sufficient funds to cover the transaction

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amount prior to effecting the transaction” (see Col. 7, lines 18-20), as noted by the Examiner. Second, applicant refers to the arguments made hereinabove with respect to items 306, 314, and 316 in Figure 3A from Hultgren and respectfully asserts that determining the customer financial institution address and the customer account identifier in order to route the authorization assurance request message in no way suggests “prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request” (emphasis added), as claimed by applicant.

Furthermore, with respect to the independent claims, the Examiner has simply dismissed applicant’s claimed “payment for the wireless network voice communication” under Official Notice. Specifically, the Examiner has stated that it would have been obvious for one of ordinary skill in the art at the time the invention was made to “add mobile phone usage payment for utility bill payment.”

Applicant respectfully disagrees. In particular, applicant respectfully asserts that Hultgren’s disclosure of “tele/datacommunications network has a service node (TSN) (30) which facilitates payment/transfer from a customer account of a customer financial institution (80) to a merchant account of a merchant financial institution (90)” (Abstract – emphasis added) in no way suggests a “method for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network,” as claimed by applicant. Clearly, Hultgren’s teachings that “[t]he TSN compares the GPS location coordinates of the merchant terminal and the current GPS coordinates of customer mobile station to determine if the two are within an acceptable proximity range” (Col. 2, lines 24-27) *teaches away* from “mobile phone usage,” contrary to the Examiner’s assertions.

In the Office Action mailed 08/24/2006, the Examiner argues that “in further review of the prior art [the Examiner] believe[s] that payment of phone service is included directly in the reference and inherent in that it clearly states ‘utility bill, for example’ (column 4, line 50).” In addition, the Examiner argues that “because Hultgren has additional features is not an indication that it is teaching away from the reference.”

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Applicant respectfully disagrees, and asserts that disclosing that if a “customer wants to pay...for a good or service, or for payment of a bill or invoice (such as a utility bill, for example)...[that] the customer merely dials the directory number of the telepay” (see Col. 4, lines 48-50), in no way specifically suggests “wireless network voice communication...and payment therefor” (emphasis added), as claimed by applicant. Further, simply disclosing that a customer may pay for a utility bill by dialing the directory number of the telepay, and a determination that the two are within an acceptable proximity range, in no way suggests the “wireless network voice communication” (emphasis added), as claimed by applicant.

Again, in view of the arguments made hereinabove, applicant formally requests a specific showing of the subject matter in ALL of the claims in any future action.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claim 2 et al., the Examiner has relied on item 60 in Figure 1 from Hultgren, with the description thereof excerpted below, to make

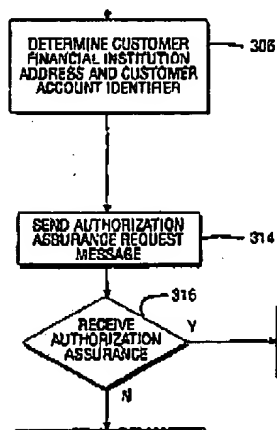
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a prior art showing of applicant's claimed technique "wherein the request is received via a mobile cellular hand set, and the pre-paid debit account is enabled by a human operator."

"The TSN (30) acquires a merchant identifier and transaction amount from a customer mobile station (60). The TSN (30) sends a transaction verification request message to both the customer mobile station (60) and the merchant terminal (70)." (Abstract - not specifically cited - emphasis added)

Applicant respectfully asserts that item 60 in Figure 1 from Hultgren merely discloses a customer mobile station that sends a merchant identifier and transaction amount to the TSN and, in return, the customer mobile station receives a transaction verification request message from the TSN. However, the mere disclosure of a customer mobile station that sends a merchant identifier and transaction amount, and receives a transaction verification request message in no way suggests any sort of enabling, let alone a specific technique "wherein the request is received via a mobile cellular hand set, and the pre-paid debit account is enabled by a human operator" (emphasis added), as claimed by applicant.

In addition, with respect to Claim 7 et al., the Examiner has relied on items 306, 314, and 316 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of applicant's claimed "transferring the payment from a previous pre-paid debit account before enabling the pre-paid debit account in response to the request."



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(Hultgren, Figure 3A, items 306, 314, and 316)

Again, applicant respectfully asserts that items 306, 314, and 316 in Figure 3A from Hultgren merely disclose "determin[ing] the customer financial institution address and the customer account identifier at the customer financial institution" (emphasis added). Hultgren continues, stating that "[t]he authorization assurance request message is routed ... to the customer financial institution address obtained at step 314" (emphasis added). In addition, Hultgren discloses receiving "the authorization assurance message" in step 316. However, items 306, 314, and 316 in Figure 3A from Hultgren simply fail to disclose a technique for "transferring the payment from a previous pre-paid debit account before enabling the pre-paid debit account in response to the request" (emphasis added), as claimed by applicant. The items referenced in Figure 3A above simply fail to even suggest any type of "previous pre-paid debit account," as claimed by applicant.

Furthermore, with respect to Claim 8 et al., the Examiner has relied on the following excerpt from Hultgren to make a prior art showing of applicant's claimed technique "wherein a balance of the pre-paid debit account is updated in real-time."

"Step 348 also shows transfer coordination module 206 sending a funds transfer requested notification message to merchant financial institution 90 over data network N. The funds transfer requested notification message alerts institution 90 to expect to receive eventually a transfer of the transaction amount to the merchant account maintained at merchant financial institution 90 from the customer financial institution 80. Such funds transfer requested notification message is depicted as event E14 in FIG. 1." (Col. 9, lines 27-35 - not specifically cited - emphasis added).

"Customer financial institution 80 can immediately transfer funds from the customer account to the merchant account at merchant financial institution 90, e.g., in accordance with usual banking procedures. For sake of simplicity, such transfer is depicted in FIG. 1 as event E15. As an option, customer financial institution 80 can also send to telepay TSN 30 a confirmation that the funds have been transferred from customer financial institution 80 to merchant financial institution 90. Merchant financial institution 90 in turn credits the merchant account with the transaction amount, which credit may possibly occur after a "float" delay." (Col. 9, lines 36-47 - emphasis added)

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Applicant respectfully asserts that the excerpt relied upon by the Examiner merely teaches that the “[c]ustomer financial institution 80 can immediately transfer funds from the customer account to the merchant account at merchant financial institution 90” (emphasis added). Further, Hultgren teaches that “institution 90 [should] expect to receive eventually a transfer of the transaction amount to the merchant account maintained at merchant financial institution 90 from the customer financial institution 80” (emphasis added). However, the mere disclosure that the funds can be immediately transferred from the customer account to the merchant account and that the merchant account should eventually receive the transfer of the transaction amount fails to suggest a technique “wherein a balance of the pre-paid debit account is updated in real-time” (emphasis added), as claimed. Clearly, an immediate transfer from a customer account to a merchant account, as in Hultgren, fails to suggest “a balance of the pre-paid debit account is updated in real-time” (emphasis added), as claimed by applicant.

Further, with respect to Claim 9 et al., the Examiner has relied on the following excerpt from Hultgren to make a prior art showing of applicant’s claimed technique “wherein an alert is sent to a user upon the pre-paid debit account falling below a predetermined amount.”

“As indicated by step 316 of FIG. 3A, if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318). Otherwise, as shown by step 320, the customer financial institution address and customer account identifier obtained from step 306, along with an indication of receipt of a positive authorization assurance message, are stored in the record for the current transaction in transaction database 220.” (Hultgren, Col. 7, lines 40-47 - emphasis added)

Applicant respectfully asserts that the excerpt from Hultgren relied upon by the Examiner merely suggests that “if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60” (emphasis added). Applicant notes, however, that such authorization assurance message is in response to a requested transaction. Thus, applicant respectfully asserts that sending an invalid transaction notification when the

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authorization assurance message is negative, in the context of Hultgren fails to disclose a technique "wherein an alert is sent to a user upon the pre-paid debit account falling below a predetermined amount" (emphasis added), as claimed by applicant. Clearly, a negative authorization assurance message that is transmitted in response to a transaction request, as in Hultgren, fails to even suggest "the pre-paid debit account falling below a predetermined amount" (emphasis added), in the manner as claimed by applicant.

Additionally, with respect to Claims 10 et al., the Examiner has relied on item 318 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of applicant's claimed technique "wherein the wireless network voice communication and the IP usage is discontinued upon the pre-paid debit account falling below a predetermined amount."



(Hultgren, Figure 3A, item 318)

"As indicated by step 316 of FIG. 3A, if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318)." (Hultgren, Col. 7, lines 39-42, not specifically cited - emphasis added)

Applicant respectfully asserts that the item and figure from Hultgren relied upon by the Examiner merely teach that "if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318)." However, sending an invalid transaction notification when the authorization assurance message is negative fails to even suggest a technique "wherein the wireless network voice communication and the IP usage is discontinued upon the pre-paid debit account falling below a predetermined amount" (emphasis added), as claimed by applicant. Clearly, a negative authorization assurance message, as in Hultgren, fails to even suggest "the pre-paid debit account falling below a predetermined amount" (emphasis added), in the manner as claimed by applicant.

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Additionally, with respect to Claims 12-15, and 29-32, the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Hultgren, in view of Official Notice, and in further view of Foladare (U.S. Patent No. 5,914,472). Applicant respectfully disagrees with such rejection. Specifically, with respect to Claim 12 et al., the Examiner has relied upon item 104 in Figure 1 from Foladare, the description thereof excerpted below, to make a prior art showing of applicant's claimed "limiting the wireless network voice communication and the IP usage based on a user-defined threshold."

"The account holder, who is the responsible person for the account, may also set a spending limit on the ancillary card, thereby restricting the spending power of the ancillary card user." (Foladare, Col. 4, lines 3-6, not specifically cited - emphasis added)

Applicant respectfully asserts that item 104 from Figure 1 merely indicates that the receiver checks to see the amount of credit available for the account holder. In addition, Foladare teaches that "[t]he account holder... may...set a spending limit on the ancillary card." However, the mere disclosure that an account holder may set a spending limit on the ancillary card in no way suggests "limiting the wireless network voice communication and the IP usage based on a user-defined threshold" (emphasis added), as claimed by applicant.

Still yet, with respect to Claim 13 et al., the Examiner has relied on Official Notice to make a prior art showing of applicant's claimed technique "wherein the user-defined threshold limitation expires after a predetermined time period." Specifically, the Examiner has argued that "it is well known to one of ordinary skill in art at the time of the invention that any variable set by the user can have time limits associated with it" because it "is just good practice to never have user inputs without time limitations on these inputs."

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Applicant respectfully disagrees and asserts that the suggestion of the account holder spending limit on the ancillary card, as in Foladare, expiring after a time limit, as suggested by the Examiner, would actually prevent the account holder from being in control of the spending of the ancillary card via the set spending limits, as in Foladare. Thus, such alleged knowledge (as purported to exist by the Examiner) actually *teaches away* from the purpose of the set spending limit in Foladare's system. Thus, Foladare's spending limit on the ancillary card, in conjunction with the Examiner's Official Notice argument, fails to suggest a technique "wherein the user-defined threshold limitation expires after a predetermined time period" (emphasis added), as claimed by applicant.

Again, in view of the above, applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action.

Furthermore, with respect to Claim 14 et al., the Examiner has relied on item 104 in Figure 1 from Foladare, the description thereof excerpted below, to make a prior art showing of applicant's claimed technique "wherein the user-defined threshold limitation expires upon receipt of a key."

"If the account holder approves the increased transaction amount at step 116, the remote transaction service provider central computer transmits an approval code for the transaction to the merchant at step 120. If the account holder does not approve the transaction at step 116, the remote transaction service provider central computer will transmit a refusal code to the merchant denying completion of the transaction at step 118." (Foladare, Col. 4, lines 49-57, not specifically cited - emphasis added)

Applicant respectfully asserts that item 116 in Figure 1 merely indicates a step in the transaction process where the account holder has the option to approve or not approve the increased transaction amount. However, the mere disclosure of an authorization step in a transaction process in no way suggests a technique "wherein the user-defined threshold limitation expires upon receipt of a key" (emphasis added), as claimed by applicant. Clearly, an approval code or a refusal code, as disclosed by Foladare, fails to even suggest that "the user-defined threshold limitation expires upon receipt of a key" (emphasis added), in the manner as claimed by applicant.

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Since at least the third element of the *prima facie* case of obviousness has not been met, as noted above, a notice of allowance or a proper prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. AMDCP005).

Respectfully submitted,
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